

Remarks

Claims 1-3, 5-11 and 13 are presently pending in the subject application. Reconsideration and allowance in view of the following remarks are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 10, 11 and 13 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Chang (U.S. Patent No. 4,849,173). Applicants respectfully traverse this rejection for the reasons that follow.

To anticipate a claim, the reference must teach every element of the claim. *See* MPEP § 2131 at 2100-73 (8th ed., Rev. 2, May 2004) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”)(citation omitted). In the present case, the Examiner has incorrectly concluded that Chang discloses a device that includes a specimen retrieval device (12) contained within a fluid-holding vessel (20) and a pierceable cap (4) fixed to an open end of the vessel. What Chang in fact discloses is a cap (4) having a central cap hole (41) into which an extension portion 51 of a packing member (5) is inserted. *See* Chang at col. 2, lines 6-12. In turn, the packing member (5) has a stem hole (52) for registering a hollow member (12) of a handle means (1). *See* Chang at col. 2, lines 12-17. Therefore, unlike the claimed invention, Chang provides no disclosure of a pierceable cap. Instead, Chang discloses that an external needle can be used to perforate a test paper 101 and a membrane 3 that are both associated with the handle means (1) not the cap (4), and that a syringe or dispenser can then inserted through the stem hole (52) in the packing member (5). *See* Chang at col. 2, lines 54-57 (step 2 of recited procedure); col. 2, lines 65-68 (step 5 of the recited procedure); and Figure 1. Accordingly, withdrawal of this rejection is respectfully requested.

Request for Reconsideration
Date: October 31, 2006

Serial No. 10/715,639
Atty. Docket No. GP106-09.DV3

Allowable Subject Matter

Claims 2, 3 and 5-9 are objected to as being dependent upon a rejected base claim. Applicants thank the Examiner for the indication that these claims would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. Applicants decline the Examiner's invitation to rewrite the claims at this time, however, as the claims are believed to be fully patentable for the reasons set forth above.

Conclusion

In view of the above remarks, Applicants submit that the subject application is in condition for allowance and notice to that effect is respectfully requested.

No fee is believed due in connection with this Request. If Applicants are mistaken, then please charge any amounts due to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

Respectfully submitted,

Date: October 31, 2006

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